

Applicant : Gianfranco D'Amato
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Attorney's Docket No.: 27514-0012001 / PA35393US-
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REMARKS

Claims 17, 22 and 37 have been amended for clarification purposes. No new subject matter has been added.

Claims 2-6, 9-13, 15-31, 33-38, 41-48 are pending.

Information Disclosure Statement

The Office action indicates that a number of references that were filed with an Information Disclosure Statement on February 24, 2010 were not considered.

Applicant thanks the Examiner for her cooperation during a phone call with its attorney, William P. O'Sullivan (Reg. No. 59,005), on January 25, 2011. During this phone call, the Examiner explained that the references not yet considered were those references that are lined through in the version of the 1449 that the Examiner returned to the Applicant.

Applicant will file an information disclosure statement with English-language versions of these references.

Double Patenting

Claims 2-6, 9-13, 15-26, 30, 31, 33-38 and 41-48 were provisionally rejected on the ground of obviousness-type double patenting as unpatentable over claims 1, 2, 4-10, 12-19, 22-27, 30, 31, 33 and 34 of .U.S. Patent Application No. 10/630,378. Applicant notes these provisional rejections and reserves the right to further address them when they are no longer provisional.

Claim Rejections -35 U.S.C. §112

Claims 17, 22, 23 and 37 were rejected under 35 U.S.C. §112, second paragraph as being indefinite. Claims 17, 22, 23 and 37 have been amended, without prejudice, to overcome these rejections.

Claim Rejections -35 U.S.C. §102/103

Claim 48 was rejected under 35 U.S.C. §103(a) as unpatentable over U.S. Patent No. 3,934,749 (Andrulionis). Applicant respectfully disagrees with this rejection.

Claim 48 recites “a container wall [that] comprises: an inner layer, a central layer; and an outer layer, . . . wherein at least one of the inner layer, the central layer or the outer layer is at least partially transparent [and] . . . , print on at least one of either an inner surface of the outer layer, an outer or inner surface of the central layer, and an outer surface of the inner layer, [and] wherein no print is provided to an outer surface of the outer layer or the inner surface of the inner layer.”

In some implementations, the claimed subject matter provides a container with printing that can be seen from outside the container (e.g., through transparent portions of the container), but that is not on either the outside of the container or the inside of the container. Thus, the printing is protected from damage that could occur from handling of the container and also does not come into contact with the product inside the container.

The Andrulionis patent does not disclose or render obvious the claimed subject matter.

The Andrulionis patent discloses a covered plastic container with a body wall 10 that may include two or more layers (e.g., 17, 18) and an outwardly-bent upper rim. Andrulioinis discloses combinations of materials that can be used to manufacture the multi-layer container, including (with the outer layer indicated last): polyethylene-polystyrene, polyethylene-HIPS, polyethylene – ABS resin, polypropylene – polystyrene, PVC –polyethylene, PVC-polystyrene, and high impact polystyrene – polystyrene. (2:60-3:4). Andrulionis further explains that “[t]he outside wall of the container . . . will be designed for aesthetic appeal including coloration, printing and decorative trim.”

Andrulionis does not disclose that “print [is provided] on at least one of either an inner surface of the outer layer, an outer or inner surface of the central layer, and an outer surface of the inner layer,” as recited in claim 48. Instead, Andrulionis only discloses that the outside wall of the container will be designed for aesthetic appeal, not any of the surfaces identified in claim 48.

Moreover, Andrulionis' disclosure of "coloration, printing and decorative trim" on its outside wall is directly contrary to claim 48, which recites, that "no print is provided to an outer surface of the outer layer."

Nor would a person of ordinary skill have had any reason to modify Andrulionis' container in a manner that would have produced the subject matter of claim 48. Indeed, the Office action identifies no such reasons.

Claim 48 is allowable for at least the foregoing reasons.

Claims 46, 2, 4-6, 9-13, 15-17, 19-21, 24, 26-31, 33, 34, 36, 41, 42 and 44 were rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 3,934,749 (Andrulionis).

Claim 46 recites a container wall that is "formed from a blank having at least two layers of a . . . material . . . [that is] dimensionally stable and fluid tight from -50°C to +120°C."

An example of the claimed subject matter is shown in FIG. 3 of the present application, which shows an exemplary cross-sectional view of a container wall 6. The illustrated wall has three layers (*i.e.*, an outer layer 3, a central layer 4 and an inner layer 5). In a typical implementation, these layers 3, 4, 5 provide dimensional stability and fluid tightness across the entire temperature range indicated in claim 46 (*i.e.*, from -50°C to +120°C). (*See ¶[0062] of the published application (2005/0006449)).*

The Andrulionis patent does not disclose or render obvious the claimed subject matter. Indeed, the Andrulionis patent is silent with respect to what range of temperatures that dimensional stability and fluid tightness will be maintained. In this regard, the Office action merely states that "[s]ince the materials recited by Andrulionis are the same as those disclosed and claimed to be useful by applicant, the container of Andrulionis would inherently be . . . fluid tight and dimensionally stable and fluid tight from -50°C to +120°C." (Emphasis added).

Inherency requires that "the missing descriptive matter [be] necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis

added). Moreover, “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” *Manual of Patent Examining Procedure*, § 2112, citing *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993).

Nothing in the Andrulionis patent indicates or even suggests that the container is dimensionally stable and fluid tight from -50°C to +120°C. Certainly, this concept is not “necessarily present” in the Andrulionis patent. The mere fact that some of the materials identified in Andrulionis may be the same as some of the materials identified in the present application for manufacturing the containers disclosed therein does not mean that the dimensional stability and fluid tightness across the -50°C to +120°C temperature range of the claimed invention will be “necessarily present” in the Andrulionis containers. Indeed, a variety of factors, beyond simply material impact the performance characteristics of a container.

For at least the foregoing reasons, the Office action’s allegation that the Andrulionis container is dimensionally stable and fluid tight from -50°C to +120°C is improper and, therefore, should be withdrawn.

Moreover, a person of ordinary skill would not have had any reason to modify Andrulionis’ container in a manner that would have led to the claimed subject matter. This is because the products that the Andrulionis patent discloses as being used with its containers typically do not get exposed to large temperature swings when placed into a container. These products include tobacco, ground coffee, fat, fruit juices, cottage cheese, margarine, peanut butter and carbonated beverages. (1:23-25 and 3:13-32). Accordingly, a person of ordinary skill would have seen no reason to modify Andrulionis’ container to make it be dimensionally stable and fluid tight up from -50°C to +120°C, as recited in claim 46.

Claim 46 is allowable for at least the foregoing reasons.

Claim 46 is allowable for other reasons as well.

For example, claim 46 recites that “the container wall is formed from a blank having at least two layers of a transparent . . . material” and that “contents of the container can be seen through the continuous container wall regardless of an orientation of the container.”

In contrast, the Andrulionis patent states that “[t]he outside wall of the container . . . will be designed for aesthetic appeal including coloration, printing and decorative trim.” (4: 47-49). The Andrulionis patent does not disclose that contents of its container can be seen through the container wall regardless of container orientation. Moreover, Applicant submits that the notion of designing the outside wall of the container for aesthetic appeal including coloration, printing and decorative trim is inconsistent with the notion of making its contents able to be seen through the continuous container wall regardless of an orientation of the container.

The Andrulionis patent discloses another material that is “essentially transparent” – the sealing layer of the container’s lid. (*See* 4:28-31 “if the sealing layer of the lid is essentially transparent, the quality of the contents may be visually inspected.” Emphasis added.) The lid’s sealing layer in the Andrulionis container, however, does not correspond to the “container wall” of claim 46; nor does the Office action allege anything contrary.

Referring to col. 4, lines 49-50 of the Andrulionis patent, the Office action states that “[t]he material for the outside wall of the container may be transparent.” However, col. 4, lines 49-50 do not clearly disclose that the material “for the outside wall” may be transparent. In relevant part, the referenced passage merely states that “[t]he material may be essentially transparent.” Applicant submits that it is very unclear what “material” is being referred to as being “essentially transparent.” Certainly, it is not clear that the “material” is “for the outside wall of the container,” as the office action concludes. Indeed, the term “essentially transparent” in the referenced passage suggests that the material being referred to could be the material in the sealing layer of Andrulionis’ lid.

Applicant submits that the ambiguous nature of the disclosure relied-upon in rejecting claim 46 does not sufficiently disclose “the container wall is formed from a blank having at least two layers of a transparent . . . material” and that “contents of the container can be seen through

the continuous container wall regardless of an orientation of the container," as required by 35 U.S.C. §102(b).

Claim 46 is allowable for at least the foregoing additional reasons.

Claims 2, 4-6, 9-13, 15-17, 19-21, 24, 26-31, 33, 34, 36, 41, 42 and 44 depend from claim 46 and, therefore, are allowable for at least the same reasons as claim 46.

Dependent claims 2, 4-6, 9-13, 15-17, 19-21, 24, 26-31, 33, 34, 36, 41, 42 and 44 may be allowable for other reasons as well.

Claim 5, for example, recites that the connection of the blank with itself is prepared by heat and pressure. The office action treats this claim as being directed to a product-by-process and concludes that the resulting structure would not be distinguishable over the Andrulioinis container. The container of claim 5, however, at least in certain implementations, is created using heat and pressure only (i.e., without the use of glue or other adhesives). Thus, the resulting structure could, in some implementations, be held together without messy and costly additional adhesive material. The Andrulioinis patent does not disclose the claimed subject matter.

Claim 5 is allowable for the foregoing additional reasons as well.

Claims 45, 47 and 38 also were rejected under 35 U.S.C. §102(b) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 3,934,749 (Andrulionis).

Claims 45 recites subject matter that is similar to subject matter recited in claim 46, discussed above. In particular, claim 45 recites "a container wall . . . formed from a blank having at least two layers of a transparent . . . material . . . such that contents of the container can be seen from all sides of the continuous container wall, and wherein the container and the material are dimensionally stable and fluid tight from -50°C to +120°C." As discussed above with reference to claim 46, the claimed subject matter is not disclosed in or obvious over the Andrulionis patent.

Claim 45 is allowable for at least the foregoing reasons.

Claim 38 depends from claim 45 and, therefore, is allowable for at least the same reasons as claim 45.

Claim 47 also recites subject matter that is similar to the subject matter recited in claim 46, discussed above. In particular, claim 47 recites “a container wall . . . formed from multiple layers of at least one temperature stable compound which is transparent and fluid tight, . . . and the container and the compound are dimensionally stable and fluid tight from -50°C to +120°C.” As discussed above with reference to claim 46, the claimed subject matter is not disclosed in or obvious over the Andrulionis patent.

Claim 47 is allowable for at least the foregoing reasons.

Claims 25 and 48 were rejected under 35 U.S.C. §103(a) as unpatentable over the Andrulionis patent.

Claims 25 and 48 depend from allowable claims and, therefore, are allowable for at least the same reasons as the claims from which they depend.

Claims 3, 6, 18, 23 and 43 were rejected under 35 U.S.C. §103(a) as unpatentable over the Andrulionis patent in view of U.S. Patent No. 2,235,963 (McGirr). Claim 35 was rejected under 35 U.S.C. §103(a) as unpatentable over the Andrulionis patent, in view of U.S. Patent No. 6,210,766 (McLaughlin). Claim 37 was rejected under 35 U.S.C. §103(a) as unpatentable over the Andrulionis patent, in view of U.S. Patent No. 2,689,424 (Clagett).

Claims 3, 6, 18, 23, 35, 37 and 43 depend from claim 46 and, therefore, are allowable for at least the same reasons as claim 46.

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Conclusion

It is believed that all rejections of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

No fee is believed to be due. Please apply any charges or credits to deposit account 06-1050.

Respectfully submitted,

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